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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,481	07/29/2003	Tomi Kimpimaki	1497-120	4680

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CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
540 WHITE PLAINS RD  
P O BOX 2005  
TARRYTOWN, NY 10591-9005

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 10/628,481	Applicant(s) KIMPIMAKI ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-19,21-49 and 51-73 is/are pending in the application.
- 4a) Of the above claim(s) 47-49 and 51-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19,21-46,72 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

This application has been re-assigned to Examiner Nathan M. Nutter in Art Unit 1711. All inquiries regarding this application should be directed to Examiner Nutter at telephone number 571-272-1076.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 October 2005 has been entered.

#### ***Response to Amendment***

In response to the amendment filed 12 October 2005, the following is being placed in effect.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-19, 21-44, 46, 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aho et al (WO 98/54410), previously cited.

Aho et al disclose a coated board and a process for its manufacture. The board comprises at least one polymer-based coat, the coat being formed from a polymer

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dispersion in which talc particles at 30-80% by wt are added. Note claim 1 at page 20 (lines 1-7). The reference teaches the employment of "polymers suitable for the polymer basis" to include styrene-butadiene, styrene acrylate, acrylate or vinyl acetate polymers and copolymers at the paragraph bridging page 4 to page 5. The reference teaches the employment of modified starches, polylactides and other biopolymers, as recited in claim 19, at page 5 (lines 7-11). The reference also shows the use of sodium carboxymethyl cellulose at example 1 on page 11. further, Aho et al teach the use of a hydrophobication agent at the paragraph bridging page 5 to page 6.

Aho et al do not specifically mention a size fraction and a pigment fraction. It would have been obvious to follow teachings of the Aho et al reference and arrive at instant composition (out of all the ingredients) into a few batches or fractions and then combine these batches to get the final product in order to facilitate smooth handling, to reduce cost of production and to obtain the final product of desired properties.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aho et al (WO 98/54,410) as applied to claim 17 above, and further in view of Niinikoski et al (US 6,753,377).

The reference to Aho et al (WO 98/54,410) does not mention the graft copolymer recited in instant claim 45.

The patent to Niinikoski et al (US 6,753,377) teaches the manufacture of a polymer dispersion, which contains a graft copolymer of starch with monomers.

It would have been obvious to use graft copolymer of Niinikoski et al in the

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manufacture of coating for board of Aho et al to impart enhanced reactivity as well as better retention and adhesion to board or paper.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-19, 21-46, 72 and 73 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 50-62 of copending Application No. 10/508,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions produced from the method herein are essentially disclosed and claimed, as well as the method for manufacture, in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 17-19, 21-46, 72 and 73 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,545,079, newly cited. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the compositions are taught by the reference for other purposes, the compositions produced would be identical, and are made using the same method as herein claimed.

### ***Response to Arguments***

Applicant argues that Aho et al provide no suggestion or teaching "to combine talc with a binder wherein the binder is a 'synthetic polymer and/or latex' and a sizing fraction comprised of a water-soluble principal component." Applicant's attention is directed to Example 1 at page 11 wherein talc is combined with 4.1 g sodium polyacrylate and 16.2 g of sodium carboxymethyl cellulose. All elements are shown, only order of addition of constituents may differ. This is not deemed to lend patentability to the claims since the specific order of addition does not result in any special features arising due to a reaction of components. All components appear to be inert to one another chemically.

Further, applicant asserts that the secondary reference to Niinikoski et al does not suggest or disclose the "present invention - that is a method of surface sizing of paper." The present claims are NOT drawn to "a method of surface sizing of paper," but rather to a method of making a size. The reference to Niinikoski et al is deemed to be relevant.

Due to the new grounds of rejection, this action is not being made FINAL.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "Nathan M. Nutter", is written over the end of the previous paragraph.

Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

27 December 2005